Doc Code: AP.PRE.REQ

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
YOR920000385US1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR

on _____

Signature _____

Typed or printed name _____

Application Number	Filed
09/652,159	08/31/2000

First Named Inventor	
Te-Kai Liu	

Art Unit	Examiner
3626	V. Frenel

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
　　　Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☑ attorney or agent of record.
Registration number   32,635

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

_____
Signature

Michael E. Whitham
Typed or printed name

(703) 787-9400
Telephone number

July 3, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

YOR920000385US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Te-Kai Liu et al.

Serial No. 09/652,159

Filed August 31, 2000

For ACCESS CONTROL FOR
    RENTAL CARS

Docket No. 00280647AA

Group Art Unit No. 3626

Examiner Vanel Frenel

Confirmation No. 2619

Box AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

    This Pre-Appeal Brief Request for Review is being concurrently filed in the USPTO with a Notice of Appeal. A check is attached to satisfy the fees for a Notice of Appeal. If any additional fees are required to satisfy the fees due for the Notice of Appeal or to gain entry and consideration of this Pre-Appeal Brief Request for Review, the Commissioner is authorized to charge Attorney's Deposit Account 50-2041 (Whitham, Curtis & Christofferson).

The Claimed Invention

    The claimed invention provides a rental car system in which cars are operated by digital keys instead of conventional keys and in which, among other things, there is no need for a data communication link between a rental car and a central station or for transaction-by-transaction reprogramming of a rental car's reader. Each car is capable of invalidating a digital key at the end of a rental period.

As shown in Figure 1, the claimed invention includes a computing system 10, a portable storage device 12, and an access control device 14 with an interface 16 to a portable storage inside a rental car 160. The computing system 10 is used to make reservations and to create and store the digital keys used to enable operation of a rental cars 160. The computing system 10 can connect to a central reservation server 110 via a network 120, which may be the Internet. The computing system 10 may be provided with a way to download a digital key to a portable storage device 12, which may take the form of a smart card issued by the car rental agency, a personal digital assistant, a memory card, or a diskette. The renter may bring a portable storage device 12 containing a digital key to a rental car 160 equipped with an access control device 14 capable of reading the digital key from the portable storage device 12 and, upon authentication of the digital key by the access control device, enable operation of the rental car 160. Upon return, the rental car 160 invalidates the digital key so that it no longer starts the car, and the renter may present the invalidated digital key to a central station of the car rental system. The digital key may be contained on a storage device provided by the renter rather than the car rental company. (Claims 6, 16; Specification, page 2, line 25, through page 3, line 2, and page 5, lines 10-15)

Errors and Omissions

The Examiner has made a number of errors and omissions, including, without limitation, the following:

- The Examiner failed to recognize that the Specification expressly provides for operation of a rental car with a digital key which may be invalidated by making a record in a storage device, as discussed more fully below; and

- The Examiner incorrectly found the invalidation of the digital key to be suggested by references which do not teach invalidation of a digital key, as discussed more fully below.

Rejection Under 35 U.S.C. § 112, First and Second Paragraphs

The Examiner rejected Claims 1-20 pursuant to 35 U.S.C. § 112, 1st and 2d paragraphs. With regard to the rejection under 35 U.S.C. § 112, 1st paragraph, the Examiner refers to "failing to comply with the enablement requirement" but does not identify the "subject matter which was not described in the specification." (Office Action at 2) With regard to the rejection under 35 U.S.C. § 112, 2d paragraph, the Examiner erroneously finds a lack of definiteness on the basis that "[i]t is unclear how the claimed invention includes 'How does a record entry invalidate a current digital key?'" (Office Action at 2)

The enablement and definiteness requirements can be addressed by reference to Figure 5 of the application and to the specification at page 7, lines 8-19. An in-car access controller 330 receives an instruction from the renter that he or she is ready to return the car. In response, the renter is prompted to insert the smart card in the smart card slot. Then, the access controller 330 obtains status information about the car (amount of fuel in tank, etc.) and creates a return packet which is electronically signed by the private key of the access controller, and this is saved into the smart card. The access controller 330 then invalidates the current digital key in step 514 by making a record in a storage device of the access controller (Specification, page 7, lines 17-19) (*e.g.*, a once valid digital key is no longer valid as soon as a copy is stored in the storage area).

In view of Figure 5 and the text in the patent specification, how to make and use the invention would be clear to one of ordinary skill in the art. The flow charts and process steps provided in the application are well within the knowledge and understanding of one of ordinary skill in the art. The Examiner's questions ("How is the key invalidated? Does the key expire on a certain date? Or does the local database include a flag that indicates the key is invalid? Or is information stored on the key that indicates the key is invalidated? Or does the key emit a signal that activates/deactivates the engine of the car?") (Office Action at 2) are not well-taken in view of the explicit discussion on invalidation of the digital key provided in Figure 5 and in the patent

specification at 7, lines 17-19. In the invention, the key is invalidated using the access controller when the renter desires to return the rental car. There are a number of steps performed in reading and writing to the smart card by the access controller with the final step being to invalidate the digital key. The Examiner is simply incorrect to interpret the feature as "any means for disabling the automobile." What is claimed is invalidating the digital key, which may be accomplished by making a record in a storage device of the access controller, as discussed in connection with Figure 5, above. Of course, the invention contemplates that invalidation of a digital key would prevent the key from being used to operate a car. As expressly recited in Claims 1 and 11, the invention contemplates "no data communications link between the fleet of cars and the management system."

<u>Rejection Under 35 U.S.C. § 103(a)</u>

The Examiner also rejected Claims 1-20 under 35 U.S.C. § 103(a), citing U.S. Patent No. 6,386,451 to Sehr in view of U.S. Published Patent Application No. 2001/0028295 to Brinkmeyer et al. These references do not suggest the invention.

Sehr teaches a method utilizing multi-application passport cards for immigration and customs applications. Sehr does not disclose a car rental system or method, though Sehr does teach that a disclosed method of using an information card may also be used for various purposes, including car rentals, hotel reservations, and so forth. Sehr also teaches that car rental use of the disclosed information card may include loading an electronic car key onto the information card. (Sehr, column 37, lines 36-38) Sehr does not, however, teach that a rental car would be capable of invalidating a digital key, as in Claim 1, lines 3-4, or dependent Claim 17.

Recognizing that Sehr does not teach invalidation of a digital key by a rental car, the Examiner erroneously relies on Brinkmeyer et al. to make up for the deficiency. (Office Action at 4-5) Brinkmeyer, et al., however, teach immobilization of a car rather than invalidation of a digital key. (Brinkmeyer et al., paragraphs 0023-0026, cited in the
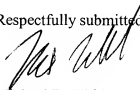
Office Action at 3). Because Brinkmeyer et al. do not teach invalidation of a digital key, they cannot be said to suggest this feature.

Thus, a combination of Sehr with Brinkmeyer et al. would not result in Claims 1-20.

<div align="center">Conclusion</div>

In view of the foregoing, it is respectfully requested that Claims 1-20 be allowed and that the application be passed to issue.

Respectfully submitted,

Michael E. Whitham
Registration No. 32,635

Whitham, Curtis & Christofferson, P.C.
11491 Sunset Hills Road, Suite 340
Reston, VA 20190
Tel. (703) 787-9400
Fax. (703) 787-7557